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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,098	02/05/2001	Robert Bernstein	4707-81342	1323
24628	7590	05/21/2007		
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			EXAMINER CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	
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			05/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/777,098	Applicant(s) BERNSTEIN, ROBERT	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the papers filed 3/6/2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 9 is an apparatus claim, yet it is presented with limitations that appear to be method steps rather than structure, rendering the claim scope unclear. Applicant should clearly further limit the apparatus with structure (i.e. elements of the apparatus which are *programmed or configured* to carry out the recited functionality). Claim 9 includes means...for identifying customer" which is proper structure, however "database...determines" is not structure.
- Claim 17 similarly includes "database...determines" which is a method step, not structure as required.
- Claim 17 recites "information provided by...vendors" – it is unclear how the source or delivery mechanism of this information can limit the structure of the database in this system claim. Is this a step of providing??

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-14, 16-20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oytac (US2003/0018613) in view of Taricani, Jr. (US6347304) or alternatively over Taricani, Jr. in view of Oytac. Oytac is a published application which enjoys the earlier benefit of and incorporates by reference provisional application number 60/221774 (filed 7/31/00). This Office Action shall refer to the disclosure of 60/221774 by page number rather than the 2003/0018613 document.

Regarding claims 1, 9, 17, Oytac teaches information providers (banks, credit card processors, etc.) that compile detailed user profiles concerning the user's purchasing histories. This is taken to provide a third party database. Information users (vendors) define desired profiles for users who are to receive targeted promotional materials. Customers who match the defined profiles are selected as the recipients of the defined promotional materials [pg 1 of 60/221774]. Oytac teaches that an interface is provided for a vendor to define the desired profile characteristics and the promotional materials to be delivered [pg 2, fig 1 of 60/221774]. The system of Oytac performs a matching of stored profiles and defined desired profiles and is taken to meet the comparator/searching limitations. Oytac's system then can automatically deliver the promotional materials. Oytac does not however explicitly state that the database

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system of consumer purchase information is one which also calculates taxes due on such purchases. Oytac describes the added value present in a system which stores digital "transaction data regarding consumer purchases". Oytac states that banks and credit card processors are two such system examples, however Oytac also states that further examples are contemplated (banks, credit card processors, "etc") [page 1 line 1]. Taricani, Jr. teaches a tax system wherein consumer transaction data is stored in a database that includes purchaser identity, dates, amounts, purchase item categories, etc. [col 7 lines 23-30]. The system of Taricani, Jr. calculates a tax due based on the consumer's purchasing history [col 7 lines 1-3]. Clearly one of ordinary skill would recognize that such a database of digital consumer purchasing data also has value for marketing purposes. It would have been obvious to have provided the features of Oytac with the system of Taricani, Jr. so that additional revenue could be generated from the valuable consumer data. Likewise, it would have been obvious that the marketing system of Oytac could be implemented with a company that provided such a tax-related consumer purchasing database.

Regarding claims 2-4, 10-12, 18, 19, Oytac teaches that a POS system can provide trigger-driven promotions printed on a receipt [pg 4]: Oytac teaches that the promotions can include coupons [pg 2].

Regarding claims 5, 13, Oytac teaches a promotional delivery channel using email [pg 4].

Regarding claims 6, 14, 20, the broad limitation that the promotional materials include "indicia of authenticity" without any corresponding steps or feature to verify the

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authenticity of such indicia can be met by any indicia printed on the promotion of Oytac. The printed materials of Oytac are taken to inherently include at least some "indicia".

Regarding claims 8, 16, 22, Oytac teaches an example where promotions are based upon types of purchases [pg 5]. Oytac also teaches the use of product categories [pg 22]. Further, Taricani, Jr. teaches that the purchasing data can also include item categorization [col 7 line 28].

Claims 7, 15, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oytac in view of Taricani, Jr. and Katz (US20020077901) or alternatively over Taricani, Jr. in view of Oytac and Katz.

Page 10 of Katz's 60/256324 has been included to demonstrate support for the important feature to 12/19/2000.

Regarding claims 7, 15, 21, Oytac teaches targeting to users based upon location [pg 5], but not necessarily based upon purchase location. Katz teaches custom promotions offered to users that includes various user profile parameters including locations where purchases were made [¶ 40]. It would have been obvious to one of ordinary skill at the time of the invention to have targeted the consumers of Oytac/Taricani with such a purchase location parameter.

Response to Arguments


Applicant's arguments have been considered, but are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc